

REMARKS

Claims 29-37, 50 and 52-62 were pending when the outstanding Office Action was mailed on April 4, 2008. Claim 50 has been amended in this paper to clarify certain aspects of this claim. Therefore, claims 29-37, 50 and 52-62 remain pending in the application.

As a preliminary matter, the applicant would like to thank Examiner Shay for holding a personal interview on June 25, 2008, with the undersigned representative, Ms. Nena Bains, and Dr. Michael Laufer. Claim 50, the references cited in the outstanding Office Action, and a proposed declaration of Michael D. Laufer, M.D., under 37 C.F.R. § 1.132 were discussed during the interview. As set forth in the Examiner's Interview Summary dated June 25, 2008, agreement was reached that the amendment to claim 50 and the declaration of Michael D. Laufer, M.D., under 37 C.F.R. § 1.132 overcome the applied rejections. The applicant thanks the Examiner for taking the time to hold the personal interview and respectfully requests that this paper constitute the Applicant's Interview Summary.

The status of the application in light of the Office Action dated April 4, 2008, is as follows:

- (A) Claims 29-37, 50 and 52-62 were rejected under 35 U.S.C. § 112, first paragraph.
- (B) Claims 29-37, 50 and 52-62 were rejected under 35 U.S.C. § 112, second paragraph.
- (C) Claims 29, 32-34, 37, 50 and 56-59 were rejected under 35 U.S.C. § 103(a) over the combination of James et al., *The Mechanics of Airway Narrowing in Asthma* ("James"), in combination with U.S. Patent No. 5,053,033 ("Clarke") and U.S. Patent No. 5,574,059 ("Regunathan").

(D) Claims 30 and 35 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and U.S. Patent No. 5,422,362 ("Vincent").

(E) Claim 36 was rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and International Publication No. WO97/37715 ("Wasksman").

(F) Claims 52-55 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and U.S. Patent No. 5,458,596 ("Lax").

(G) Claims 60-62 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan, U.S. Patent No. 6,008,211 ("Robinson"), and U.S. Patent No. 4,754,065 ("Levenson").

(H) Several different combinations of the pending claims were rejected under the doctrine of obviousness-type double patenting as being unpatentable over one or more claims of the following issued patent and/or later filed co-pending applications:

- (1) U.S. Patent No. 5,972,026
- (2) U.S. Patent Application No. 11/614,919;
- (3) U.S. Patent Application No. 11/612,620;
- (4) U.S. Patent Application No. 11/618,533;
- (5) U.S. Patent Application No. 11/609,242;
- (6) U.S. Patent Application No. 11/608,606;
- (7) U.S. Patent Application No. 11/425,345;
- (8) U.S. Patent Application No. 11/421,444;
- (9) U.S. Patent Application No. 11/398,353;

- (10) U.S. Patent Application No. 11/408,668;
- (11) U.S. Patent Application No. 11/420,442;
- (12) U.S. Patent Application No. 11/361,564;
- (13) U.S. Patent Application No. 11/117,905;
- (14) U.S. Patent Application No. 10/810,276;
- (15) U.S. Patent Application No. 11/617,512;
- (16) U.S. Patent Application No. 11/562,910;
- (17) U.S. Patent Application No. 11/614,914; and
- (18) U.S. Patent Application No. 11/562,925.

A. Response to the Rejection Under Section 112, First Paragraph

Claims 29-37, 50 and 52-62 were rejected under 35 U.S.C. 112, first paragraph, on the grounds that the phrase "such that ability of the smooth muscle to contract is reduced" was not described in the originally filed specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. Although the applicant does not concede the merits of this rejection, claim 50 has been amended to read "such that the ability of the airway to contract is reduced." Support for this feature is found, for example, at page 11, lines 5-9, of the originally filed specification. This portion of the specification states "[t]he elimination of the smooth muscle tissue prevents the hyperactive airways of an asthma patient from contracting..." As discussed with the Examiner during the personal interview, claim 50 complies with the written description requirement of 35 U.S.C. § 112, first paragraph. Therefore, the applicant respectfully requests withdrawal of this rejection.

B. Response to the Rejection Under Section 112, Second Paragraph

Claims 29-37, 50 and 52-62 were rejected under 35 U.S.C. 112, second paragraph on the grounds that the phrase "such that the ability of the smooth muscle to contract is reduced" was found to lack positive antecedent basis in the originally filed disclosure. Claim 50 has been amended and is fully supported by the originally filed disclosure as explained above. Therefore, the applicant also respectfully requests withdrawal of this rejection.

C. Response to the Section 103(a) Rejection - James, Clarke and Regunathan

Claims 29, 32-34, 37, 50 and 56-59 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke and Regunathan. Pursuant to the agreement reached during the personal interview on June 25, 2008, the Declaration of Michael D. Laufer, M.D., Under 37 C.F.R. § 1.132 overcomes this rejection. Therefore, the applicant respectfully requests withdrawal of this rejection.

D. Response to the Section 103(a) Rejection - James, Clarke, Regunathan and Vincent

Claims 30 and 35 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and Vincent. Pursuant to the agreement reached during the personal interview on June 25, 2008 the Declaration of Michael D. Laufer, M.D., Under 37 C.F.R. § 1.132 overcomes this rejection. Therefore, the applicant respectfully requests withdrawal of this rejection.

E. Response to the Section 103(a) Rejection - James, Clarke, Regunathan and Waksman

Claim 36 was rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and Waksman. Pursuant to the agreement reached during the personal interview on June 25, 2008, the Declaration of Michael D. Laufer, M.D., Under 37

C.F.R. § 1.132 overcomes this rejection. Therefore, the applicant respectfully requests withdrawal of this rejection.

F. Response to the Section 103(a) Rejection - James, Clarke, Regunathan and Lax

Claims 52-55 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan and Lax. Pursuant to the agreement reached during the personal interview on June 25, 2008, the Declaration of Michael D. Laufer, M.D., Under 37 C.F.R. § 1.132 overcomes this rejection. Therefore, the applicant respectfully requests withdrawal of this rejection.

G. Response to the Section 103(a) Rejection - James, Clarke, Regunathan, Robinson and Levenson

Claims 60-62 were rejected under 35 U.S.C. § 103(a) over the combination of James, Clarke, Regunathan, Robinson and Levenson. Pursuant to the agreement reached during the personal interview on June 25, 2008, the Declaration of Michael D. Laufer, M.D., Under 37 C.F.R. § 1.132 overcomes this rejection. Therefore, the applicant respectfully requests withdrawal of this rejection.

H. Response to Double Patenting Rejections

Claims 29-37, 50 and 52-62 were also rejected under the doctrine of obviousness-type double patenting over one or more claims of (a) an issued patent and (b) a number of later filed copending applications. The present application, however, antedates all of the copending applications listed in the obviousness-type double patenting rejections. Therefore, pursuant to MPEP § 804, if the present application is in condition for allowance before issuance of the listed copending applications, then the present application should not be subject to an obviousness-type double patenting rejection over those applications. With respect to the obviousness-type double patenting rejection of U.S. Patent No. 5,972,026, this rejection is improper because a Terminal Disclaimer regarding U.S. Patent

No. 5,972,026 was already filed in the present application on October 31, 2007, in response to the previous Office Action. Therefore, the applicant respectfully requests withdrawal of all of the outstanding obviousness-type double patenting rejections.

I. Conclusion

In view of the foregoing, the pending claims comply with the requirements of 35 U.S.C. § 112 and are patentable over the applied art. The applicant accordingly requests reconsideration of the application and respectfully submits that the application is in condition for allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Paul T. Parker at (206) 359-8000.

Dated: July 22, 2008

Respectfully submitted,

By 

Paul T. Parker

Registration No.: 38,264
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-6088
(206) 359-7088 (Fax)
Attorney for Applicant